

## **REMARKS**

The Final Office Action mailed August 1, 2008 has been received and reviewed. Prior to the present communication, claims 28-63 were pending in the subject application. Each of claims 28-63 stands rejected. Claim 28 has been amended and claim 29 has been canceled. It is respectfully submitted that no new matter is added by way of the present amendments. Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested.

### **Rejections based on 35 U.S.C. § 103**

#### **A.) Applicable Authority**

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP §2143 through §2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)”. See MPEP §2143. The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed

invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivation found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. *See, Application of Bergel*, 292 F. 2d 955, 956-957 (1961).

Recently, the Supreme Court elaborated, at pages 13-14 of the *KSR* opinion, that “it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007). Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972 (Bd. Pat. App. & Inter. 1985).” *Id.* *See also* MPEP §706.02(j) and §2142.

**B.) Obviousness Rejection Based on U.S. Publication No. 2002/0090934 to Mitchelmore in View of U.S. Publication No. 2002/0180803 to Kaplan**

Claims 28-35, 38-47, 50-59, 62, and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0090934 to Mitchelmore (hereinafter “the

Mitchelmore reference") in view of U.S. Publication No. 2002/0180803 to Kaplan (hereinafter "the Kaplan reference"). As the asserted combination of references fails to teach or suggest all of the limitations of rejected claims 28-35, 38-47, 50-59, 62, and 63, Applicants respectfully traverse this rejection, as hereinafter set forth.

Independent claim 28, as amended herein, is generally directed to a method for creating a user profile. The method includes, upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile containing data files, application settings and user environment settings, wherein the user environment settings comprise a user's desktop configuration, start menu configuration or other operating system shell configurations. Further, the method includes, in response to detecting that no existing user profile is found on the PSD, automatically launching a user profiled connection wizard that enables the user to create a user profile on the PSD, wherein the user profile configuration wizard allows a user to select which content data will be synchronized between the PSD and the computing device.

It is respectfully submitted that the Mitchelmore reference fails to teach or suggest, upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile containing data files, application settings and user environment settings, wherein the user environment settings comprise a user's desktop configuration, start menu configuration or other operating system shell configurations.

Contrary to the invention of independent claim 28, the Mitchelmore reference is generally directed toward a system and method for delivering content to hand-held devices such as web-enabled phone and personal data assistants for managing content on these devices. *See, Mitchelmore reference, Abstract.* This content delivery and management system may alert a user

to view content, or, in another embodiment, may be of use to customer service organizations where time specific events are relevant to end users. *See id.* at ¶¶ [0014] and [0055]. According to another embodiment, the invention of the Mitchelmore reference may allow an end user to select information from any Internet source that is relevant to their personal needs. *See id.* at ¶ [0017].

The Mitchelmore reference does not teach or suggest scanning for an indication of an existing user profile, and in fact, does not even mention a user profile, as the Mitchelmore reference is not directed to the creation of user profiles at all. The Office Action suggests that FIG. 6 of the Mitchelmore reference, along with ¶¶ [0100], [0055], and [0016] provide support for the Office Actions rejection of claim 28. *See*, Office Action, p. 3. FIG. 6 “illustrates interaction and cooperation of components of the content delivery and management system. . . .” but still does not provide support for scanning the PSD for an indication of an existing user profile containing data files, application settings, and user environment settings. *See* Mitchelmore reference at FIG. 6 and ¶ [0085]. Further, ¶ [0100] generally discusses a synchronization agent that is used to synchronize subscription manager configuration information with handheld devices, but still does not disclose scanning a storage device for an indication of an existing user profile having the data as described in claim 1. *See id.* at ¶ [0100].

Furthermore, the Mitchelmore reference also fails to teach or suggest, in response to detecting that no existing user profile is found on the PSD, automatically launching a user profiled connection wizard that enables the user to create a user profile on the PSD, wherein the user profile configuration wizard allows a user to select which content data will be synchronized between the PSD and the computing device. The Office Action admits that the Mitchelmore reference “does not disclose in response to detecting that no existing user profile is found on the

PSD, automatically launching a user profiled connection wizard that enables the user to create a user profile on the PSD.” Office Action at p. 3.

It is respectfully submitted that the Kaplan reference fails to cure the deficiencies of the Mitchelmore reference, in that it also does not teach or suggest, upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile containing data files, application settings and user environment settings, wherein the user environment settings comprise a user’s desktop configuration, start menu configuration or other operating system shell configurations. Nor does the Kaplan reference teach or suggest in response to detecting that no existing user profile is found on the PSD, automatically launching a user profiled connection wizard that enables the user to create a user profile on the PSD, wherein the user profile configuration wizard allows a user to select which content data will be synchronized between the PSD and the computing device.

The Kaplan reference, on the other hand, is generally directed toward a multimedia management system for storing, manipulating, displaying, and packaging multimedia content. *See*, Kaplan reference, Abstract. The Kaplan reference also includes “the ability to organize multimedia content stored on flash media readers, with flash memory being used by many digital devices for temporary storage of multimedia content.” *Id.* at ¶ [0009]. A software wizard may be automatically launched upon detection of the flash memory, and the wizard may prompt the user to organize and store the multimedia content. *See id.* Multimedia content may then be organized based upon instructions provided in association with the multimedia content. *See id.*

The Office Action attempts to supports its rejection of claim 1 by citing to ¶ [0009] of the Kaplan reference. *See* Office Action at p. 4. This portion of the Kaplan reference discloses that the invention “provides the ability to organize multimedia content stored on flash media readers, with flash memory being used by many digital devices for temporary storage of multimedia content.” Kaplan reference at ¶ [0009]. The Office Action does not cite to a particular portion of this section of the Kaplan reference. This section does discuss a feature of the Kaplan reference wherein upon detection of the flash memory, a software wizard may automatically launch to prompt the user on organizing the storing the multimedia content. “Without the user having to perform any function, the multimedia content will be automatically organized within the multimedia management system based upon instructions provided in association with the multimedia content.” *Id.* A software wizard that prompts the user on organizing and storing the multimedia content is not a user profile connection wizard that enables the user to create a user profile on a storage device.

The Kaplan reference does not even mention an ability to create a user profile, nonetheless mention or discuss automatically launching a user profile connection wizard that enables the user to create a user profile on a storage device. As the only portion of the Kaplan reference that is used to reject claim 1 is ¶ [0009], and as it has been made clear above that the Kaplan reference **does not teach** automatically launching a user profile connection wizard that **enables the user to create a user profile** on a storage device, the Kaplan reference cannot be used to reject independent claim 1. In order to make a *prima facie* case of obviousness, the prior art references, when combined, must teach or suggest **all of the claim limitations**. Here, this is not the case, as neither the Mitchelmore reference nor the Kaplan reference, nor the references combined, teach or suggest all of the claim limitations. In order to meet this standard, the

references, when combined, must teach or suggest scanning the PSD for an indication of an existing user profile, and in addition, must teach or suggest in response to detecting that no existing user profile is found on the PSD, automatically launching a user profile connection wizard that enables the user to create a user profile on the PSD. There is absolutely no indication in either reference that a user profile may be created, nonetheless created using an automatically launched user profile connection wizard.

As such, it is respectfully submitted that the Mitchelmore and Kaplan references, whether taken alone or in combination, fail to teach or suggest all of the limitations of independent claim 28, as amended herein, and as such, a *prima facie* case of obviousness of claim 28 cannot be established utilizing these references. Additionally, independent claims 40 and 52 include features similar to those discussed above with respect to independent claim 28, and as such, the Mitchelmore and Kaplan references fail to teach or suggest all of the limitations of claims 40 and 52 as well. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 28, 40, and 52 under 35 U.S.C. §103(a). Independent claims 28, 40, and 52 are believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 29-35, 38-39, 41-47, 50-51, 53-59, and 62-63 depend, either directly or indirectly, from one of independent claims 28, 40, or 52 and, accordingly, it is respectfully submitted that the Mitchelmore and Kaplan references fail to teach or suggest all of the limitations of these claims for at least the above-cited reasons. As such, the withdrawal of the § 103(a) rejections of claims 29-35, 38-39, 41-47, 50-51, 53-59, and 62-63 is respectfully requested. Each of claims 29-35, 38-39, 41-47, 50-51, 53-59, and 62-63 is believed to be in condition for allowance, and such favorable action is respectfully requested.

**C.) Obviousness Rejection Based on U.S. Publication No. 2002/0090934 to Mitchelmore in View of U.S. Publication No. 2002/0180803 to Kaplan in Further View of U.S. Publication No. 2003/0028451 to Ananian**

Claims 36-37, 48-49, and 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mitchelmore and Kaplan and further in view of U.S. Publication No. 2003/0028451 to Ananian (hereinafter “the Ananian reference”). As the Mitchelmore, Kaplan, and Ananian references, either alone or in combination, fail to teach or suggest all of the claim limitations of claims 36-37, 48-49, and 60-61, Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 36-37, 48-49, and 60-61 depend, either directly or indirectly, from one of claims 28, 40, or 52, and are therefore patentable over the Mitchelmore, Kaplan, and Ananian reference for at least the reasons cited above. Moreover, claims 36-37, 48-49, and 60-61 recite further novel, non-obvious features not taught or suggested in the cited references in the context of independent claims 28, 40, and 52. Accordingly, Applicants respectfully request withdrawal of the § 103(a) rejections of claims 36-37, 48-49, and 60-61 as well. Claims 36-37, 48-49, and 60-61 are believed to be in condition for allowance and such favorable action is respectfully requested.

## **CONCLUSION**

For at least the reasons stated above, claims 28-63 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or [emcfarland@shb.com](mailto:emcfarland@shb.com) (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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